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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,122	02/15/2002	Herbert Peiffer	01/026 MFE	2899

7590

12/19/2002

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EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 12/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,122

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/077,454 in view of ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S).

Application No. 10/077,454 claims a transparent, biaxially oriented film with the recited particle contents, optical and surface properties, orientation characteristics, method of orienting and heat-setting, post-treatment, and use of recycled material. However, the Application does not explicitly claim a multilayer film.

ULLMANN'S discloses that it is well known in the art to combine multiple polymer films and functional coatings to form multilayer films in order to allow optimization of

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mechanical, sealing, barrier, and other physical properties (sections 2.4.2-2.4.3 and 6.13), wherein the multilayer films are formed by conventional methods such as coextrusion.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the film layer claimed in Application No. 10/077,454 into multilayer film structures containing an additional polyester layer and optionally another functional coating layer as suggested by ULLMANN'S in order to tailor the mechanical, adhesion, heat-sealing, and other physical properties of the laminate for a specific application. One of ordinary skill in the art would have selected the appropriate thicknesses of the surface or coating layers as indicated in claim 4 depending on the specific type of materials used in the layer and the particular property-enhancing function of said layers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over SATO (US 5,648,159) in view of PEIFFER ET AL (US 5,955,181).

SATO discloses a multilayer biaxially oriented polyester film having a typical overall thickness of 20-22 microns (Example 1) wherein the film comprises a base layer, a first surface layer having a typical thickness of 0.005-1 micron and containing 0.1-20 wt% particles having an average particle size of 0.01-3 microns on one surface of the base layer, and a second surface layer on the opposite surface having at typical thickness of 0.8 microns (Example 6), wherein the particles in the first surface layer have a small particle size distribution (line 30, col. 2 to line 50, col. 4; lines 58-60, col. 5) as recited in claims 1-4. The film has a haze of not more than 1.5% (lines 12-14, col. 6) as recited in claim 5. The film is formed by coextrusion, sequential biaxial orientation, and heat-setting at temperatures and stretch ratios comparable to those recited in claims 8-9, followed by post-treatment such as corona discharge.

PEIFFER ET AL '181 discloses that it is well known in the art to form biaxially oriented multilayer polyester films using the method recited in claims 8-9 and further to surface treat the oriented films as recited in claim 10 to improve adhesion and to recycle 20-50 wt% of scrap material back into the film (line 45, col. 7 to line 35, col. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to minimize the variation in size of the particles used in the film of SATO in order to obtain laminate films with uniform surface properties. It also would have been obvious to subject the SATO films to conventional post-treatments as disclosed in PEIFFER ET AL '181 in order to improve adhesion to subsequently applied coatings. One of ordinary skill in the art would have adjusted the film gloss as indicated in claim 5 depending on the optical and surface properties desired for a specific end use. It would have been obvious to recycle scrap material into the films of SATO as indicated in claim 11 in order to reduce waste and material costs. The

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Examiner has reason to believe that the particle size distributions disclosed in SATO are comparable to the spread in grain size distribution recited in claims 1, 3, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

KATOH ET AL (US 4,818,581) and HASEGAWA ET AL (US 5,077,118) disclose transparent polyester films with narrow particle size distributions.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

December 13, 2002



Vivian Chen
Primary Examiner
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